

REMARKS

This Amendment is submitted in reply to the final Office Action mailed on July 31, 2006. A petition for a one month extension of time is submitted herewith. The Director is authorized to charge \$120.00 for the petition for extension of time and any additional fees which may be required, or to credit any overpayment to Deposit Account No. 02-1818. If such a withdrawal is made, please indicate the Attorney Docket No. 112701-443 on the account statement.

Claims 1, 2, 4-15 and 17-23 are pending in this application. Claims 3 and 16 were previously canceled. In the Office Action, Claims 1, 2, 4-15 and 17-23 are rejected under 35 U.S.C. §112, first paragraph, and Claims 1 and 14 are rejected under 35 U.S.C. §103. In response Claims 1 and 14 have been amended. This amendment does not add new matter. In view of the amendment and/or for the reasons set forth below, Applicants respectfully submit that the rejections should be withdrawn.

In the Office Action, Claims 1, 2, 4-15 and 17-23 are rejected under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the written description requirement. More specifically, the Patent Office asserts that independent Claims 1 and 14 fail to comply with the written description requirement with respect to the recitation “to *above* the extraction head.” *See*, Office Action, page 2. In response, Applicants have amended independent Claims 1 and 14 to remove the word “above” from the claims. Further, the Patent Office asserts that independent Claims 1 and 14 fail to comply with the written description requirement with respect to the recitation “*allowing* gas to displace” the piston. *Id.* Applicants respectfully disagree that this subject matter was not disclosed in the specification and believe that one skilled in the relevant art, at the time the application was filed, would recognize that Applicants had possession of the claimed invention because the specification clearly states that gas pressure is used to empty the chamber and the piston is “displaced by compressed gas.” *See*, specification, page 2, lines 20-24; and page 4, lines 5-10. It is further noted that Applicants have amended independent Claims 1 and 14 to recite, in part, allowing a compressed gas to displace the piston so as to empty the chamber of water.

Based on at least these noted reasons, Applicants respectfully submit that Claims 1, 2, 4-15 and 17-23 fully comply with 35 U.S.C. §112, first paragraph and respectfully request that the rejection under 35 U.S.C. §112 be withdrawn.

In the Office Action, Claims 1 and 14 are rejected under 35 U.S.C. §103(a) as being unpatentable over WO 00/02081 to Gschwend ("*Gschwend*") in view of U.S. Patent No. 3,918,355 to Weber ("*Weber*"). Applicants believe this rejection is improper and respectfully traverse it for at least the reasons set forth below. In consideration of the aforementioned amendments, Applicants respectfully submit that there is no suggestion or motivation to combine *Gschwend* and *Weber* to obtain the present claims, and even if combinable, all of the claimed elements are not taught or suggested by *Gschwend* and *Weber*.

Applicants respectfully submit that there is no suggestion or motivation to combine *Gschwend* and *Weber* to obtain the present claims because the mode of operation of the device in each reference is completely different. For example, *Gschwend* is directed toward a coffee machine for mobile use using compressed air to move liquid from a reservoir to a brewing unit. The liquid is, therefore, in direct contact with the compressed air, there being no intermediate used to move the liquid from the reservoir to the brewing unit.

In contrast to *Gschwend*, *Weber* is directed toward an infusion apparatus where liquid is pushed from a first chamber to a second chamber by the a piston that is actuated by the force of gravity. In *Weber*, the piston is in direct contact with the liquid as the force of gravity acts on the weight of the piston forcing the liquid under substantially constant pressure through the passage into the second chamber. Although the apparatus of *Weber* utilizes a piston to empty the first chamber, the piston is entirely driven by the force of gravity as opposed to being driven by compressed gas, as is required by the present claims. In fact, each and every example that is disclosed in *Weber* discloses moving water by a piston carried downwardly by the weight of the piston. Therefore, there exists no motivation to combine the cited references to arrive at the present claims.

As discussed above, *Gschwend* uses compressed air to empty the first chamber whereas *Weber* uses the force of gravity to move a piston to empty the reservoir. Consequently, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

What the Patent Office has done is to rely on hindsight reconstruction of the claimed invention. Applicants respectfully submit that it is only with a hindsight reconstruction of Applicants' claimed invention that the Patent Office is able to even attempt to piece together the

teachings of the prior art so that the claimed invention is allegedly rendered obvious. Instead, the claims must be viewed as a whole as defined by the claimed invention and not dissected into discrete elements to be analyzed in isolation. *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1548, 220 USPQ 303, 309 (Fed. Cir. 1983); *In re Ochiai*, 71 F.3d 1565, 1572, 37 USPQ2d 1127, 1133 (Fed. Cir. 1995). One should not use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fine*, 837 F.2d at 1075. (Fed. Cir. 1988).

Applicants also respectfully submit that, even if combinable, all of the claimed elements are not taught or suggested by the cited references. For example, as noted by the Patent Office, *Gschwend* fails to disclose or suggest a piston in the chamber that is displaced by the gas under pressure as required, in part, by Claims 1 and 14. *See*, Office Action, page 3. *Gschwend* also fails to disclose or suggest a valve for allowing compressed gas to displace the piston so as to empty the chamber of water as required, in part, by Claims 1 and 14. Further, *Gschwend* also fails to disclose or suggest an intermediate chamber between the reservoir and the extraction chamber as required, in part, by Claims 1 and 14. Instead, *Gschwend* discloses a coffee machine for mobile use using compressed air to move a liquid directly from a reservoir to a brewing unit, where the entire reservoir must be kept under constant gas pressure to be able to deliver liquid into the brewing chamber. Because *Gschwend* fails to disclose a piston intermediate the liquid and compressed air, there is direct contact between air and liquid which can create a gasified liquid that is undesirable for beverages such as coffee. Moreover, the machine of *Gschwend* requires a large quantity of gas to maintain the reservoir under constant pressure and, thus, there exists a need for venting the reservoir before being able to replenish the reservoir. Similarly, it is also difficult to meter the exact quantity of the liquid dispersed from such a device.

Weber is also deficient with respect to the present claims. For example, *Weber* fails to disclose or suggest a piston in the chamber that is displaced by a gas under pressure as required, in part, by Claims 1 and 14. *Weber* also fails to disclose or suggest a valve for selectively allowing gas to displace the piston so as to empty the chamber of water as required, in part, by Claim 1. Further, *Weber* also fails to disclose or suggest an intermediate chamber between a reservoir and an extraction chamber. Instead, *Weber* is directed toward an infusion apparatus for dispensing a quantity of a heated liquid where liquid is pushed from a first chamber into a second chamber by the force of a weight acting as a piston on the liquid of the first chamber. In *Weber*,

the piston is actuated upon effect of gravity and is released when a final temperature is reached as controlled by a thermostatic means. Moreover, the first chamber that contains liquid to be heated is not automatically replenished when the piston is moved upward and the exact quantity of liquid cannot be easily metered from the reservoir since all of the liquid contained in the reservoir is emptied in one shot.

For at least the reasons discussed above, the combination of *Gschwend* and *Weber* is improper. Moreover, even if combinable, *Gschwend* and *Weber* do not teach, suggest, or even disclose all of the elements of Claims 1 and 14 and Claims 2, 4-15 and 17-23 that depend from Claims 1 and 14, and thus, fail to render the claimed subject matter obvious.

Accordingly, Applicants respectfully request that the rejections of Claims 1, 2, 4-15 and 17-23 under 35 U.S.C. §103 be withdrawn.

For the foregoing reasons, Applicants respectfully request reconsideration of the above-identified patent application and earnestly solicit an early allowance of same.

Respectfully submitted,

~~BELL, BOYD & LLOYD LLC~~

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